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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/113,712	07/18/98	HELINSKI	E EN997043

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EXAMINER  
DEXTER, C

ART UNIT  
3724

PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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<b>Office Action Summary</b>	Application No. <b>09/113,712</b>	Applicant(s) <b>Helinski</b>
	Examiner <b>Clark F. Dexter</b>	Group Art Unit <b>3724</b>

Responsive to communication(s) filed on \_\_\_\_\_.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) 12-20 is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-11 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-11, drawn to a punch and die apparatus, classified in class 83, subclass 138.
  - II. Claims 12-18, drawn to a method of aligning dies, classified in class 83, subclass 13.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and materially different process; for example, the dies can be aligned using any desirable method.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. Eric Franklin on March 23, 1999, a provisional election was made without traverse to prosecute the invention of group I, claims 1-11.

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Affirmation of this election must be made by applicant in replying to this Office action.

Claims 12-18 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

***Information Disclosure Statement***

5. The information disclosure statement filed July 10, 1998 has been received and the references listed thereon have been considered.

***Drawings***

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the first and second alignment marks as set forth in claims 4 and 9 must be shown or the features cancelled from the claims. No new matter should be entered.

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*Abstract*

7. The abstract of the disclosure is objected to because in lines 4 and 6, it seems that "die" should read --die-receiving--. Correction is required. See MPEP § 608.01(b).

*Specification*

8. The disclosure is objected to because of the following informalities:
- On page 5, line 20, --1-- should be inserted after "punch".
- On page 8, lines 20, "openings" appears to be inaccurate, and it seems that it should read --opening-- or the like.
- On page 10, line 10, "34" appears to be inaccurate, and it seems that it should read --35--.
- On page 11, line 7, "or" appears to be incorrect, and it seems that it should read --on-- or the like; in lines 11-12, "die-receiving passage" is unclear as to which one (i.e., "34" or "35"); in line 14, it seems that "a dōe" should read --the die-- since this feature has already been introduced.
- On page 12, line 12, a numeral (e.g., 50) should be inserted after "passage".
- On page 15, lines 18 and 19, numerals should be inserted after "passage" and "housing" for clarity.
- On page 17, line 7, --(not shown)-- should be inserted after "sensor" for clarity; similarly, in line 11, --(not shown)-- should be inserted after "display" for clarity.

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On page 18, line 1, the phrase is awkwardly worded, and it seems that "and" should be deleted.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112, 1st paragraph***

9. Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In general, it is not clear as to how the punch operates as depicted in Figure 2 wherein the upper die 25 is partially inserted into the die-receiving passage 34 of the lower housing 33. That is, it is not clear how the material is positioned between the upper die 25 and lower die 26.

***Claim Rejections - 35 USC § 112, 2nd paragraph***

10. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 6-7, structural cooperation is not positively set forth between the first die passage and the first die, and it is suggested to simply delete "for"; similarly, in lines 8-9, structural cooperation is not positively set forth between the second die passage and the second

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die, and it is suggested to simply delete "for"; in lines 10-11, the phrase "and permitting at least one of the first die and the second die to rotate therein" renders the limitation vague and indefinite since sufficient structure has not been set forth to provide for such a function.

In claim 3, lines 2-3, the phrase "permits at least the first die to rotate therein" renders the limitation vague and indefinite since sufficient structure has not been set forth to provide for such a function.

In claim 5, line 3, "may be aligned to be concentric within about 5 millionths of an inch" is vague and indefinite as to what is being set forth, particularly since no structure is set forth to provide for the recited function, and thus the scope of the limitation cannot be ascertained.

In claim 6, lines 6-7, structural cooperation is not positively set forth between the first die passage and the first die, and it is suggested to simply delete "for"; similarly, in lines 8-9, structural cooperation is not positively set forth between the second die passage and the second die, and it is suggested to simply delete "for"; in lines 10-11, the phrase "and permitting at least one of the first die and the second die to rotate therein" renders the limitation vague and indefinite since sufficient structure has not been set forth to provide for such a function.

In claim 8, lines 2-3, the phrase "permits at least the first die to rotate therein" renders the limitation vague and indefinite since sufficient structure has not been set forth to provide for such a function.

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In claim 10, line 3, "may be aligned to be concentric within about 5 millionths of an inch" is vague and indefinite as to what is being set forth, particularly since no structure is set forth to provide for the recited function, and thus the scope of the limitation cannot be ascertained.

In claim 11, line 3, structural cooperation is lacking for "a compression spring", and it is suggested to simply delete "for"; also in line 3, "in" renders the limitation vague as to how (or when) the punch is being biased, and it is suggested to change it to --to-- or the like.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.

Communications via Internet e-mail regarding this application, other than those under 35 USC 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [rinaldi.rada@uspto.gov].

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All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 USC 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.



**Clark F. Dexter  
Primary Examiner  
Art Unit 3724**

cfd  
March 29, 1999